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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,004

04/08/2004

Ballie Michel

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466 7590 12/23/2008

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EXAMINER

BRUNSMAN, DAVID M

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

12/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,004	<b>Applicant(s)</b> MICHEL, BALLIE	
	<b>Examiner</b> David M. Brunzman	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-34 is/are pending in the application.
- 4a) Of the above claim(s) 26, 27, 39 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-25, 28-38 and 41-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 18-34 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-17-2008 has been entered.

Applicant's response includes newly amended claims, A declaration under Rule 132 and remarks. The amendment to claim 18, the independent claim expands to the scope of the claim to include compositions free of catalyst and limits the compositions having a catalyst to those wherein the catalyst is a octanoate or naphthenates of Co, Nr or Mn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-25, 28-38, 41-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The instant claims limit the product made to those having the properties recited in claim 18 as (e1) or (e2). The declaration filed in applicant's response tests compositions meeting every material and procedural limitation of the instant claims (based on Example IV or the reference) that yet fail to exhibit the required properties.

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There is no teaching of record of which steps must be performed, different from those of the declaration, in order to make a product that has the required properties.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-25, 28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2749247.

Example IV of the reference teaches a composition made by heating rosin ester gum and linseed oil to 200 C and stirring them together at 240 C. This intermediate product meets every compositional limitation of the instant claims. As these properties are inseparable from the materials, it would be expected that the composition exhibit properties (e1) or (e2). Evidence presented that this prior art mixture does not should include an explanation how the instant specification teaches one of ordinary skill in the art to ensure that otherwise similar compositions do not possess the required properties.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-25, 28, 29 and 31-38 and 41-43 rejected under 35 U.S.C. 103(a) as being unpatentable over US 2749247, in view of Barnes et al.

Example IV of US 2749247 teaches a composition comprising “(b)” linseed (flax) (viscosity about 30 Pa.s) and “(a)” rosin ester (boiling point about 120 C) with cobalt linoleate added as a drier (catalyst) and a coloring agent of lamp black, considering the Tung oil as a component of “(b)”, the composition would contain a ratio of a to b of 33:67. While the mixture is formulated with 300cc of an organic solvent in apparent contradiction to the “consisting essentially of” language of the instant claims, the dried coating formed would be essentially free of organic solvent as it is driven off during drying. It is the dried composition which would be expected to have properties similar to those recited in the instant claims. While the dried form (on a glass plate) of the reference may not lend itself to penetrability testing, the composition still has such a property. Applicant’s declaration does not measure that property. The patent teaches compositions having the same ingredients in proportions falling within the scope of the instant claims. The claim limitation “for the production of a layer and/or a coating containing aggregates for road works and civil engineering is very broad and would encompass anything used in the pavement industry or having to do with buildings in any way. As a material’s properties are inseparable from that material, it would be expected that the compositions of the reference would exhibit all the properties recited in the instant claims. No evidence to the contrary is of record.

The difference between the patent example and the instant claims is the anion of the cobalt salt. Page 16 of the Barnes et al reference teaches the octanoate salt of

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cobalt is a useful drier for drying oils in addition to the linoleate salt of the patent.

Furthermore, applicant admits, page 3, line 11, in the declaration that cobalt linoleate and cobalt octanoate are "well known equivalents". It would have been obvious to one of ordinary skill in the art to substitute cobalt octanoate as the drier in the patent example because Barnes et al teach it is useful as such.

This application contains claims 26, 27, 39 and 40 drawn to an invention nonelected with traverse in the reply filed on 16 November 2007.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, Th, F, Sa; 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David M Brunsman/  
Primary Examiner, Art Unit 1793

DMB